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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,157	06/25/2003	David M. Reilly	VI/03-002	3562
21140	7590	03/19/2007	EXAMINER	
GREGORY L BRADLEY MEDRAD INC ONE MEDRAD DRIVE INDIANOLA, PA 15051			GILBERT, ANDREW M	
			ART UNIT	PAPER NUMBER
			3767	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/606,157	Applicant(s) REILLY ET AL.	
	Examiner Andrew M. Gilbert	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgments

1. This office action is in response to the reply filed on 12/20/2006.

Election/Restrictions

2. Claims 18, 22, and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/20/2006.
3. Applicant's election with traverse of claims 1-17 and 19-21 in the reply filed on 12/20/2006 is acknowledged. The traversal is on the ground(s) that claims 1-23 have already been subject to a search and consideration and there is no serious burden on the examiner in concluding the prosecution of claims 1-23. This is not found persuasive because the current Examiner is examining this case for the first time, having taken the case over from the previous Examiner who has left the office, and because Inventions I and II are *independent and distinct inventions* and there would be a serious burden on the examiner if the restriction was not required because they require different fields of search (see Restriction Requirement mailed 11/21/2006).
4. Thus, the restriction requirement is maintained.
5. Claims 1-17 and 19-21 are pending for examination.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 9/18/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

7. Claim 14 is objected to because of the following informalities: Claim 14 recites "abut" in line 21 and the Examiner the recitation should read "about". Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the at least one release member being positioned *axially forward* of the at least one attachment member" (emphasis added). However, the Applicant has not recited in claim 1 which end of body of the syringe is the rearward and forward ends and thus the Examiner does not know what is the "axially forward" direction of the attachment member. The Examiner suggests structurally reciting which of the syringe body is the forward/rearward end to give a frame of reference to determine the axially forward direction. For purposes of this examination, the Examiner has assumed that the Applicant intended to reference that the at least one attachment member is associated

at the rearward end of the body where the syringe attaches to the injector and thus the at least one release member is positioned axially forward, or positioned forward towards the forward injection end of the body, of the at least one attachment member. The appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Neer et al (5279569). Neer et al discloses a syringe (Fig 4) for use with an injector comprising a syringe retaining mechanism (Fig 4; col 11, Ins 10-40), the syringe comprising: a body (30) comprising a rearward end and a forward end; a plunger (54) movably disposed within the body; and at least one attachment member (37, 46; Fig 4) associated with the body, the at least one attachment member comprising a flexible ring (46; col 7, 59-61) operable to releasably attach the syringe to the injector; wherein rotation of the syringe about its axis when attached to the injector causes deformation of the flexible ring to enable detachment of the syringe from the injector (46, col 7, Ins 59-61; col 11, Ins 10-40; wherein the Examiner notes that the O-ring (46) is fully capable of

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performing the function of the intended use language by forming a seal between the flange (37) and the jacket (31) securing the syringe in the door (25) and when the syringe is rotated and released, the O-ring's seal is released, allowing the O-ring to return to its normal shape by releasing the pressure exerted thereon by the flange and jacket, thus helping to allow the syringe to be detached from the injector.

12. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Bendek et al (5921966). Bendek et al discloses a syringe (Fig 1) for use with an injector comprising a syringe retaining mechanism (16a, b), the syringe comprising: a body (46, 18) comprising a rearward end and a forward end; a plunger (46b) movably disposed within the body; and at least one attachment member (18 a, c) associated with the body, the at least one attachment member comprising a flexible ring (18 a, c; Fig 5a; col 4, lns 21-24) operable to releasably attach the syringe to the injector.

13. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Fago et al (6569127). Fago et al discloses an injector (Fig 5-10) for injecting fluid from a syringe mounted thereon, the injector comprising: a housing (48); a drive member (13) at least partially disposed within the housing and operable to engage a plunger disposed within the syringe; and a syringe retaining mechanism (Fig 8-10, col 8, lns 7-46) associated with the housing and being operable to releasably seat the syringe upon axial rearward motion of the syringe relative to the syringe retaining mechanism regardless of the orientation of syringe about the axis of the syringe (Fig 8-10, col 8, lns 7-46), the syringe retaining mechanism consisting essentially of a flexible ring (90a, b; 92a; col 8, lns 18-24) maintained at a fixed axial position within the syringe retaining mechanism.

14. Claims 13 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Trocki et al (6652489).

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

15. In reference to claim 13, Trocki et al discloses an injector for injecting fluid from a syringe mounted thereon (Fig 1), the injector comprising: a housing; a drive member at least partially disposed within the housing and operable to engage a plunger disposed within the syringe; and a syringe retaining mechanism (2100; Fig 46a) associated with the housing and being operable to releasably seat the syringe upon axial rearward motion of the syringe relative to the syringe retaining mechanism regardless of the orientation of syringe about the axis of the syringe, the syringe retaining mechanism consisting essentially of a flexible ring (2150) maintained at a fixed axial position within the syringe retaining mechanism (the Examiner notes that "consisting essentially of" has been interpreted as a middle ground type statement wherein the claim must be interpreted as having only the claimed components and those that do not materially affect the basic and novel characteristics of the claimed invention – In the instant case, the syringe retaining mechanism is essentially the flexible ring (2150) and the

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additionally parts, ie the front and back plates (2152, 2154) act simple to hold and position the flexible ring in a fixed axial position in the injector and do not materially affect the basic or novel characteristics of the claim invention consisting essentially of a flexible ring).

16. In reference to claim 19, Trocki et al disclose a syringe (Fig 18) for use with an injector comprising a syringe retaining mechanism (16), the syringe comprising: a body (32) comprising a rearward end and a forward end; a plunger (38) movably disposed within the body; and at least one attachment member associated with the body (70), the at least one attachment member comprising a flexible ring (70, 30; Fig 18-20) operable to releasably attach the syringe to the injector.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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18. Claims 1-17, 19-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-39, 53 of U.S. Patent No. 6652489. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending parent case. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application and it has been held that the generic invention is anticipated by the species.

19. Claims 1-17, 19-21 of this application conflict with claims 13-21 of Application No. 10/668673. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Response to Arguments

20. Applicant's arguments filed 6/20/2006 with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

